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Model Lexi Boling exits the Fendi show at Theatre des Champs-Elysees in a Fuct cap on July 8, 2015, in Paris
Melodie Jeng/Getty Images

INSIGHT: Words Not Fit for Polite Company? The *Brunetti* Case



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Are “immoral” or “scandalous” trademarks shielded by the First Amendment? Arnold & Porter attorneys say the Supreme Court will soon hear oral arguments in a case that could affect pending PTO applications for “swear words,” impact other statutory bars to trademark registration, and offer clues to how the court will address First Amendment cases.

“[O]ne man’s vulgarity is another’s lyric.”

So Justice Harlan so famously observed in upholding a Vietnam War protestor’s First Amendment right to wear a jacket emblazoned with the phrase “F**k the Draft.” (See *Cohen v. California*, 403 U.S. 15 (1971)).

The U.S. Supreme Court will again consider the reach of the First Amendment to shield expletives—this time in trademark registrations—when it hears *Iancu v. Brunetti*, No. 18-302, on April 15. (The authors take poetic license with the “vulgar” words throughout this article.)

At issue in *Brunetti* is whether the bar on federal trademark registration of “immoral” or “scandalous” matter in Section

2(a) of the Lanham Act, 15 U.S.C. § 1052, violates the First Amendment. According to the Patent and Trademark Office (the PTO), respondent Erik Brunetti's apparel displaying the word "F-U-C-T" was immoral, scandalous, and thus not entitled to registration, although Brunetti claimed "FUCTION" simply meant "Friends yoU Can't Trust".

The Federal Circuit reversed, holding the "immoral or scandalous" provision in Section 2(a) unconstitutional in violation of the First Amendment as impermissible content-based discrimination.

Brunetti is a key case for several reasons, among them:

- the insight it may provide on how the newly composed court addresses First Amendment cases;
- its effect on pending PTO applications for "swear words"; and
- its potential impact on other statutory bars to trademark registration.

The Trend of First Amendment Decisions *Brunetti* may prove a harbinger of First Amendment decisions to come. Recently, in *Matal v. Tam*, 137 S. Ct. 1744 (2017), the court held unconstitutional, as a violation of the First Amendment, another prohibition in Section 2(a) on registration of trademarks that "disparage" or bring into "contemp[t] or disrepute" any persons.

Logically, the court would also find the ban on registering immoral or scandalous marks unconstitutional. And, although the composition of today's court differs from that in *Tam*, Justices Neil Gorsuch and Brett Kavanaugh, who did not hear *Tam*, had been solidly pro-First Amendment votes on the Tenth and D.C. Circuits, respectively. There is, thus, good reason to expect that the ban on registrability of "immoral" or "scandalous" material is likely to fall.

Effect of *Brunetti* on Pending PTO Cases While not essential to trademark use, registration with the PTO confers benefits on a trademark owner, such as *prima facie* evidence that the mark is valid, and that the registrant has exclusive rights to use the mark nationwide for the goods and services for which it is registered.

The PTO has suspended more than a dozen trademark applications containing ostensibly "immoral or scandalous" words pending the disposition of *Brunetti*—at least temporarily depriving these trademark owners of the benefits of registration.

Yet, the PTO has allowed other trademarks containing the same words to register, reflecting the subjective judgment of the individual PTO lawyers who review pending applications, as well as the context in the way these words are used.

For example:

Application Suspended Pending <i>Brunetti</i> (Goods or Services)	Registered Mark (Goods or Services)
KICK THE SH*T OUT OF OPTION B (Offering strategies for becoming more resilient in the face of adversity)* *the authors represent the applicant in this matter	FCUK (Leather goods, soaps, perfume)
HOLY SH*T (T-shirts)	BACON B*TCH BACON BITCH  (Restaurant services; Fast-food restaurant services)

Source: U.S. Patent and Trademark Office

Bloomberg Law

Were the court to strike the ban on registration of "immoral" or "scandalous" matter, the PTO would lift its suspension on the applications for HOLY S**T and the like, and these marks would proceed to registration upon proof of use in commerce.

This ruling would also invite applications for trademarks containing the famed "seven dirty words" as enumerated by the late comedian George Carlin.

Potential Impact on Other Statutory Bars to Registration Section 2(a) of the Lanham Act includes other bars to federal registration, principal among them the bans on registration of marks creating a false association with "persons, living or dead, institutions, beliefs, or national symbols" or of "deceptive" matter.

For instance, *In re Jackson Int'l Trading Co.*, 103 U.S.P.Q.2d 1417 (T.T.A.B. 2012), held the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY was properly refused registration because it falsely suggested a connection with the musician Benny Goodman.

And, *In re Budge Mfg. Co., Inc.*, 857 F.2d 773 (Fed. Cir. 1988), upheld the refusal to register LOVEE LAMB as deceptive for car seat covers made from lamb or sheep products, when the products were actually made of synthetic materials.

Unlike the disparagement clause and the ban on registration of immoral or scandalous matter, these clauses should not be prone to constitutional challenge on First

Amendment grounds, as they do not implicate any limitations on expressive speech.

Instead, these provisions in Section 2(a) are consistent with the purpose of the trademark laws, which, as the Supreme Court observed in *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763 (1992), is to prevent consumer confusion and “protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get.”

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